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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/592,462	06/09/2000	Tracy E. Grim	480032-307	4478

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EXAMINER

PATTERSON, MARIE D

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 04/11/2003

26

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/592,462

Applicant(s)

GRIM ET AL.

Examiner

Marie Patterson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 and 33-71 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-23 and 39-41 is/are allowed.
- 6) ☒ Claim(s) 33-38, 42-58 and 67-71 is/are rejected.
- 7) ☒ Claim(s) 59-66 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Reissue Applications

1. Claims 37, 50, 57, 58, 61, and 67-71 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Claims 37, 50, 57, 58, 61, and 67-71 do not contain the limitations "an inner sole extending substantially over the entire sole area" and "said grid of resilient sections comprising substantially all of said inner sole and extending over substantially all of said sole area" which were added and argued in the amendment filed 6/17/96 which resulted in the Examiner allowing claim 17, now patented claim 19 which is the broadest claim in the original patent. Therefore, applicant has previously surrendered the subject matter of an inner sole which does not extend substantially over the entire sole area with a grid of resilient sections which does not comprise substantially all of the inner sole and

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extends over substantially the entire sole area. It is also noted that these limitations were argued by application for patentability in the amendment filed 6/17/96.

Note MPEP 1412.02 which states "The recapture rule bars the patentee from acquiring through reissue claims that are, in all aspects, of the same scope as, or are broader in scope than, those claims canceled from the original application to obtain a patent. Ball, 729 F.2d at 1436, 221 USPQ at 295." Canceled claim 20 of parent application 08/360798 recited "....an inner sole extending substantially over the entire sole area mounted in said footgear above said outer sole, said inner sole having a plurality of removable sections that are removably mounted in said footgear and that area arranged in a grid pattern, said removable sections having lower surfaces which are removably secured within said footgear and said sections together....said grid...comprising substantially all of said inner sole and extending substantially over the entire sole area.", therefore claims which do not require such are considered to be barred in a reissue application per MPEP 1412.02. Claims 50-54, 57, and 58 are considered to be broader or of the same scope as the canceled claim 20 in the prior application and therefore barred.

2. The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.

3. The reissue Declaration filed with this application is defective (see 37 CFR 1.175 and MPEP 1414) because of the following:

The original Declaration is not relevant to the newly filed claims.

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4. It is noted that applicant has requested that the requirement for new Declarations be deferred until claim language is finalized and thus such a requirement is deferred and will be required when the claims are finalized.

Double Patenting

5. Applicant is advised that should claims 51 and 52 be found allowable, claims 57 and 58 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

6. Claims 50-52, 54, 55, 57, and 58 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The removability of the resilient sections is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The removability of the sections is a critical and essential feature/limitation required for the footwear to function as desired and disclosed. There is no disclosure as to how the shoe without this feature would function in the desired manner.

7. Claims 45, 50-52, 54-58, 70, and 71 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 45, 70, and 71 the phrase "that sway laterally to a substantial extent" is vague and indefinite because it is not clear what structural limitations applicant intends to encompass with such language. What extent is considered to be substantial?

In claims 50, 57, and 58 the phrase "independently vertically movable resilient sections" is vague and indefinite because it is not clear what structural limitations applicant intends to encompass with such language. There is no structural limitations claimed which facilitate the functional recitation of "vertically movable". In response to applicants' arguments directed towards such, the fact that the sections are made of resilient material does not make them "vertically movable". The top surface of the

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section make be vertically movable by the resiliency of the sections, however the sections would appear to remain unmoved vertically. Also, it is noted that the claim recited that the sections are "independently vertically movable", what recited structures allow such a function to occur?, i.e. what structures are intended to be encompassed by such language. If applicant merely intends to encompass that the sections are resilient then why is such a limitation/recitation needed, i.e. what structures are intended to be encompassed.

In claim 71 the phrase "of substantial height" is confusing, vague, and indefinite because it is not clear what structural limitations applicant intends to encompass with such language. What height is considered to be "substantial", there is no guidance as what height is considered to be substantial.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States

9. Claims 48 and 49 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Ma (4598484).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be

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patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 33-38, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kellerman in view of Andrews (4793078) and Moronaga (4633598).

Kellerman shows a pad/footgear comprising a flexible sheet (12 or an insert as discussed in column 8, lines 3-8) and removable resilient sections (34) forming a resilient layer substantially as claimed except for orienting the insert so that the removable resilient sections are an upper layer and making the inner sole sections from multiple layers. Andrews teaches providing an insert with removable resilient sections with the removable sections being the upper layer adjacent a wearer's foot to better relieve pressure at sensitive areas of a wearers' foot. Moronaga teaches forming an insole pad from three layers with progressively different softnesses. It would have been obvious to provide the inserts on the upper surface of the insole/pad as taught by Andrews and to make the insole from three different layers as taught by Moronaga in the pad/footgear of Kellerman to better relieve pressure at regions of swelling, pain, or inflammation (as discussed in Kellerman in column 6 lines 4-7) and to provide better shock absorption and cushioning and to conform the insole to "suit the user's requirements" (column 2 lines 21-22).

12. Claims 42, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grim (5078128) in view of Kellerman and Andrews (4793078).

Grim shows a footgear comprising an outer sole (25), flaps and arrangement with an open toe (shown in figure 6), and an inner sole (200) substantially as claimed except for the exact inner sole. Grim suggests the use of customizing cushion construction in column 3 lines 42-45. Kellerman teaches customizing cushion construction by providing

a pad comprising a flexible sheet (12 or an insert as discussed in column 8, lines 3-8) and removable resilient sections (34) forming a resilient layer for relieving pressure at regions of swelling, pain, or inflammation (column 6 lines 4-7). Andrews teaches providing an insert with removable resilient sections with the removable sections being the upper layer adjacent a wearer's foot to better relieve pressure at sensitive areas of a wearers foot. It would have been obvious to provide a pressure relieving insert insole as taught by Kellerman and to provide the removable sections on the upper surface of the insert as taught by Andrews in the footgear of Grim to relieve pressure at sensitive areas of a patients foot and thereby customize the cushion for the specific patient.

13. Claims 42-45, 50, 54, 55, 56, 70, and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kellerman in view of Andrews (4793078).

Kellerman shows footgear comprising a flexible sheet (12 or an insert as discussed in column 8, lines 3-8) and removable resilient sections (34) forming a resilient layer substantially as claimed except for orienting the insert so that the removable resilient sections are an upper layer. Andrews teaches providing an insert with removable resilient sections with the removable sections being the upper layer adjacent a wearer's foot to better relieve pressure at sensitive areas of a wearers' foot. It would have been obvious to provide the removable sections on the upper surface of the insole/pad as taught by Andrews in the footgear of Kellerman to better relieve pressure at regions of swelling, pain, or inflammation (as discussed in Kellerman in column 6 lines 4-7) and to provide better shock absorption and cushioning and to conform the insole to "suit the user's requirements" (column 2 lines 21-22).

14. Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 42-45 above, and further in view of Cavanagh (4608768).

Kellerman as modified above shows footgear substantially as claimed except for hook and loop fasteners on the bottom of the inner sole to connect it to the outer sole. Cavanagh teaches the use of hook and loop fasteners on the bottom of an inner sole to provide releasable secure connection of the inner sole to the footgear (column 4 lines 25-30). It would have been obvious to provide hook and loop fasteners as taught by Cavanagh in the footgear of Kellerman as modified above to provide secure and removable attachment for the inner sole.

Allowable Subject Matter

15. Claims 1-23, and 39-41 are allowed.

16. Claims 59-66 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

17. Claims 51 and 52 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims and amended to overcome the recapture rejection and the double patenting warning.

18. Claims 57, and 58 would be allowable if amended to overcome the recapture rejection and the double patenting warning.

19. Claims 53, and 67-69 would be allowed if amended to overcome the recapture rejection.

Response to Amendment

20. The Declaration under 37 CFR 1.132 filed 3/17/03 is sufficient to overcome the rejection of claims 42-45, 47, 50-52, and 54-58 based upon Kuhn, Foldes, or Ma, because these claims have been amended to recite "said sections having upper surfaces which together form a substantially smooth and continuous upper surface" which is what the Declaration refers to.

21. The Declaration under 37 CFR 1.132 filed 3/17/03 is insufficient to overcome the rejection of the claims as set forth in the last Office action because: There has been no designation of nexus between the Long Declaration and the claims as required by MPEP 716.03. Also, See also *Pentec, Inc. v. Graphic Controls Corp.*, 776 F.2d 309, 227 USPQ 766 (Fed. Cir. 1985) (commercial success may have been attributable to extensive advertising and position as a market leader before the introduction of the patented product); *In re Fielder*, 471 F.2d 690, 176 USPQ 300 (CCPA 1973) (success of invention could be due to recent changes in related technology or consumer demand; here success of claimed voting ballot could be due to the contemporary drive toward greater use of automated data processing techniques); *EWP Corp. v. Reliance Universal, Inc.*, 755 F.2d 898, 225 USPQ 20 (Fed. Cir. 1985) (evidence of licensing is a secondary consideration which must be carefully appraised as to its evidentiary value because licensing programs may succeed for reasons unrelated to the unobviousness of the product or process, e.g., license is mutually beneficial or less expensive than defending infringement suits); *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d1367, 231 USPQ 81 (Fed. Cir. 1986). SALES FIGURES MUST BE ADEQUATELY

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DEFINED Gross sales figures do not show commercial success absent evidence as to market share, *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 226 USPQ 881 (Fed. Cir. 1985), or as to the time period during which the product was sold, or as to what sales would normally be expected in the market, *Ex parte Standish*, 10 USPQ2d 1454 (Bd. Pat. App. & Inter. 1988)

Response to Arguments

22. Applicant's arguments filed 3/17/03 have been fully considered but they are not persuasive.

In response to applicants' arguments on pages 8-11 of the response filed 3/17/03, these statements are not persuasive.

In response to applicants' arguments directed towards the 112 first paragraph enablement rejection, applicant references column 3 lines 20-24 which refer to a broader aspect of the invention and refers to an inner sole having mobile sections of the type described in the preceding paragraph. The preceding paragraph clearly recites "made up of separate resilient sections removably secured to a flexible sheet to form substantially flat surface fore....sections of the inner sole are removed to provide pressure relief". This recitation clearly is directed towards removing sections to perform the recited functions and the paragraph referenced by applicant clearly points to the paragraph which specifically recites the removability. There is no suggestion for the sections to not be removable in either of these paragraphs. In response to the referenced paragraph on column 13 lines 10-20, this paragraph references "the various

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embodiments of the present invention...", all of the various embodiments disclosed and shown by applicant do have removable sections. There are no embodiments disclosed which do not show and describe such and therefore this paragraph is directed towards the various embodiments disclosed which all show removable sections.

In response to Applicant's argument that the prior art is intended to be used in a different environment/by different people, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgement on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. *In re McLaughlin*, 443 F.2d 1392; 170 USPQ 209 (CCPA 1971). Clearly both the patent to Kellerman and the patent to Andrews are directed towards insoles with removable sections which are removably attached to an insole and that said sections may be removed as desired to accommodate a patient's need, i.e. customize the insole for relief of pressure in a specific area. To combine the teachings of these references is clearly not hindsight, but merely using the knowledge clearly disclosed by two references which are directed towards the same problem.

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In response to Applicant's piecemeal analysis of the references, it has been held that one cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references. In re Keller, 208 USPQ 871 (CCPA 1981). Applicant has provided many arguments as to how the individual references function, but has not addressed the resultant insole as recited in the rejection which is a combination of the references, specifically the reference to Kellerman modified by the teachings of Andrews.

In response to applicants' arguments directed towards the coefficient of friction of the sections of Kellerman, there is nothing in applicants' claims which require otherwise. It is the claims that define the claimed invention, and it is claims, not specifications that are anticipated or unpatentable. Constant v. Advanced Micro-Devices Inc., 7 USPQ2d 1064.

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA) 1969. In this case, both references are directed

towards devices with removable elements to relieve pressure to customize an insole, the teachings of these references are clearly combinable and the suggestion of such is clear in that both references are directed towards similar devices and similar means for solving the same problem.

In response to applicants' arguments directed towards the "swaying" of the sections, the cited references and rejection above show all of the positively recited structures and are inherently capable of performing the recited function of swaying inasmuch as the claims have defined such. The sections of Kellerman and/or Andrews are clearly capable of swaying due to the sections being separate and independent. The fact that these sections are thin, there is no thickness requirement in the rejected claims, and the thin sections of the prior art are clearly capable of "swaying" to some degree.

1. Telephone inquiries regarding the status of application or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the Examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148 or the **Tech Center 3700 Customer Service Center number is (703) 306-5648**. For applicant's convenience, the Group Technological Center FAX number is (703) 872-9302. (Note that the Examiner **cannot** confirm receipt of faxes) Please identify Examiner ____ of Art Unit ____ at the top of your cover sheet of any correspondence submitted.

Inquiries only concerning the **merits** of the examination should be directed to Marie Patterson whose telephone number is (703) 308-0069.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g. copies of references cited, form PTO-1449, for PTO-892, etc. requests for copies of such papers should be directed to (703) 308-1337.

Check out our web-site at "www.uspto.gov" for fees and other useful information.



Marie Patterson
Primary Examiner
Art Unit 3728